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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/749,811	12/30/2003	Hans-Joachim Schreiber	089986-000000US	5328

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EXAMINER
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ZIMMERMAN, JOHN J

ART UNIT	PAPER NUMBER
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1775

DATE MAILED: 11/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/749,811	SCHREIBER ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	John J. Zimmerman	1775	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. ____   |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>20031230</u> .  | 6) <input type="checkbox"/> Other: ____                                     |

## **FIRST OFFICE ACTION**

### ***Priority***

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Information Disclosure Statement***

2. The Information Disclosure Statement filed with this application has been considered. An initialed form PTO-1449 is enclosed with this Office Action.

### ***Specification***

3. The disclosure is objected to because of the following informalities: The specification is objected to because it refers to specific claim numbers and subject matter (e.g. see page 2, second paragraph; page 5, sixth through ninth paragraphs). Since the subject matter and numbering of the individual claims may change during prosecution or during printing of a patent that may issue from this application, the specification should not refer to individual claims and their subject matter. In addition, applicant should insert proper headings at their appropriate locations in the specification (e.g. "Cross-References to Related Applications", "Description of the Prior Art", "Brief Description of the Drawings", "Summary of the Invention", "Detailed Description of the Invention", etc. . .). Appropriate correction is requested.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-38 are rejected under 35 U.S.C. 102(b) as being anticipated by Ishikawa (Japanese Publication 09-085306).

6. Ishikawa discloses a method of making dull finished stainless steel having a random pattern with no directivity by rolling it with a roll (e.g. see paragraphs [0005]-[0031]). The dimensions of pattern fall within the dimensions required by the pending claims. Regarding method limitations in the product claims (e.g. claim 33), when there is a substantially similar product, as in the applied prior art, the burden of proof is shifted to the applicant to establish that their product is patentably distinct not the examiner to show that the same process of making, see *In re Brown*, 173 U.S.P.Q. 685, and *In re Fessmann*, 180 U.S.P.Q. 324. Regarding claims to shaped parts (e.g. claims 33-35), it is understood by one of ordinary skill in the art that the sheets of Ishikawa will be used in manufacture of stainless steel articles. There is no particular structure associated with the generic recitation of a sink top, mixer tap or work top and therefore the stainless steel product of Ishikawa anticipates the claims reciting these structures.

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7. Claims 1-38 are rejected under 35 U.S.C. 102(b) as being anticipated by McClain (U.S. Patent 3,556,874).

8. McClain discloses applying a non-directional lustrous matte finish to stainless steel sheets by embossing them with a grit blasted rollers in order to make the stainless steel resistant to abrading and fingerprinting (e.g. see column 3, line 30 - column 4, line 64). The pattern formed by grit blasting is random and the dimensions of embossments created by the grit of McClain would fall within the dimensions required by the pending claims (e.g. see Examples 1-2). Regarding method limitations in the product claims (e.g. claim 33), when there is a substantially similar product, as in the applied prior art, the burden of proof is shifted to the applicant to establish that their product is patentably distinct not the examiner to show that the same process of making, see *In re Brown*, 173 U.S.P.Q 685, and *In re Fessmann*, 180 U.S.P.Q. 324. Regarding claims to shaped parts (e.g. claims 33-35), it is understood by one of ordinary skill in the art that the sheets of McClain will be used in manufacture of architectural and engineered articles (e.g. see column 1, lines 55-64). There is no particular structure associated with the generic recitation of a sink top, mixer tap or work top and therefore the product of McClain anticipates the claims reciting these structures.

9. Claims 1-39 are rejected under 35 U.S.C. 102(b) as being anticipated by Shannon (U.S. Patent 6,153,316).

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10. Shannon discloses a method of making a non-directional, diffuse reflecting sheet surface having randomly formed microscopic depressions (e.g. column 2, lines 46-50; see Figures 1-4B) and wherein the surface is rolled by a chrome plated steel alloy work roll having the randomly formed surface texture (e.g. column 3, line 35 - column 4, line 29). The roll may have a preferred range of 300-550 peaks per inch and a sheet roughness range RA of 10-55 microinches (e.g. see column 4, lines 30-49).

11. Claims 1-38 are rejected under 35 U.S.C. 102(b) as being anticipated by Hino (Japanese Publication 04-046612).

12. Hino discloses a method of making dull finished stainless steel by rolling it with a roll whose surface is pitted by shot blasted alumina grit (e.g. see abstract and entire disclosure). Shot blasting is a random process that forms random irregular microscopic depressions on the roll which are transferred to the stainless steel sheet surface. The dimensions of grit fall within the dimensions required by the pending claims. Regarding method limitations in the product claims (e.g. claim 33), when there is a substantially similar product, as in the applied prior art, the burden of proof is shifted to the applicant to establish that their product is patentably distinct not the examiner to show that the same process of making, see *In re Brown*, 173 U.S.P.Q. 685, and *In re Fessmann*, 180 U.S.P.Q. 324. Regarding claims to shaped parts (e.g. claims 33-35), it is understood by one of ordinary skill in the art that the sheets of Hino will be used in manufacture of stainless steel articles. There is no particular structure associated with the

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generic recitation of a sink top, mixer tap or work top and therefore the stainless steel product of Hino anticipates the claims reciting these structures.

13. Claims 1-38 are rejected under 35 U.S.C. 102(b) as being anticipated by Sasaki (Japanese Publication 61-115606).

14. Sasaki discloses a method of making finger print resistant metal sheets by rolling the sheets with a roll whose surface is pitted by shot blasting (e.g. see abstract, Table 1, Figures 1-2). Shot blasting is a random process that forms random irregular microscopic depressions on the roll which are transferred to the metal sheet surface. The surface roughness dimensions of the sheets are disclosed in Table 1 and fall within the dimensions required by the pending claims. Regarding method limitations in the product claims (e.g. claim 33), when there is a substantially similar product, as in the applied prior art, the burden of proof is shifted to the applicant to establish that their product is patentably distinct not the examiner to show that the same process of making, see *In re Brown*, 173 U.S.P.Q. 685, and *In re Fessmann*, 180 U.S.P.Q. 324. Regarding claims to shaped parts (e.g. claims 33-35), it is understood by one of ordinary skill in the art that the sheets of Sasaki will be used in manufacture of copper articles. There is no particular structure associated with the generic recitation of a sink top, mixer tap or work top and therefore the metal product of Sasaki anticipates the claims reciting these structures.

15. Claims 1-38 are rejected under 35 U.S.C. 102(b) as being anticipated by Nawata (Japanese Publication 06-246305).

16. Nawata discloses a method of making stainless steel sheets (e.g. paragraph [0012]) having a random irregular pattern by rolling it with a roll (e.g. see paragraphs [0006]-[0009]; Figures 1-2). The dimensions of pattern fall within the dimensions required by the pending claims. Regarding method limitations in the product claims (e.g. claim 33), when there is a substantially similar product, as in the applied prior art, the burden of proof is shifted to the applicant to establish that their product is patentably distinct not the examiner to show that the same process of making, see *In re Brown*, 173 U.S.P.Q 685, and *In re Fessmann*, 180 U.S.P.Q. 324. Regarding claims to shaped parts (e.g. claims 33-35), it is understood by one of ordinary skill in the art that the sheets of Nawata will be used in manufacture of shaped articles (e.g. see deep drawing in paragraph [0011]; Figure 3). There is no particular structure associated with the generic recitation of a sink top, mixer tap or work top and therefore the product of Nawata anticipates the claims reciting these structures.

17. Claims 1-38 are rejected under 35 U.S.C. 102(b) as being anticipated by Clarke (U.S. Patent 3,051,080).

18. Clarke discloses applying an architectural finish to stainless steel sheets by embossing them with a grit blasted rollers (e.g. see claims 1-6). The pattern formed by grit blasting is random and the dimensions of embossments created by the grit of Clarke would fall within the dimensions required by the pending claims. Regarding method limitations in the product claims (e.g. claim 33), when there is a substantially similar product, as in the applied prior art, the



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burden of proof is shifted to the applicant to establish that their product is patentably distinct not the examiner to show that the same process of making, see *In re Brown*, 173 U.S.P.Q 685, and *In re Fessmann*, 180 U.S.P.Q. 324. Regarding claims to shaped parts (e.g. claims 33-35), it is understood by one of ordinary skill in the art that the sheets of Clarke will be used in manufacture of architectural articles. There is no particular structure associated with the generic recitation of a sink top, mixer tap or work top and therefore the product of Clarke anticipates the claims reciting these structures.

19. Claims 1, 5-17 and 21-38 are rejected under 35 U.S.C. 102(b) as being anticipated by Martin (U.S. Patent 3,153,278).

20. Martin discloses a method of making an aluminum sheet having a random pattern with no directivity by rolling it with a roll (e.g. see Figure 4; column 6, lines 30-43). Regarding method limitations in the product claims (e.g. claim 33), when there is a substantially similar product, as in the applied prior art, the burden of proof is shifted to the applicant to establish that their product is patentably distinct not the examiner to show that the same process of making, see *In re Brown*, 173 U.S.P.Q 685, and *In re Fessmann*, 180 U.S.P.Q. 324. There is no particular structure associated with the generic recitation of a sink top, mixer tap or work top and therefore the disclosed products of Martin (e.g. panel and trim for appliances, architectural paneling, furniture, etc. . . ) anticipate the claims reciting these structures.

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21. Claims 36-39 are rejected under 35 U.S.C. 102(b) as being anticipated by Broderick (U.S. Patent 3,924,313).

22. Broderick discloses a roller having a random etched pattern surface and a chrome plating (e.g. see Figure 2). Although it is noted that the Broderick may not disclose that his device is for structuring the surface of a metal sheet, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

23. Claims 1-38 are rejected under 35 U.S.C. 102(b) as being anticipated by Furukawa (U.S. Patent 4,795,6814).

24. Furukawa discloses a prior art process of producing a random peak/valley embossed finish to metal sheets by embossing them with a grit blasted or discharge worked rollers (e.g. see Figure 1 and Table 2). The patterns formed by grit blasting and discharge working are random and the dimensions of embossments created by the rollers of Furukawa would fall within the dimensions required by the pending claims. Regarding method limitations in the product claims (e.g. claim 33), when there is a substantially similar product, as in the applied prior art, the burden of proof is shifted to the applicant to establish that their product is patentably distinct not the examiner to show that the same process of making, see *In re Brown*, 173 U.S.P.Q 685, and *In*

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*re Fessmann*, 180 U.S.P.Q. 324. Regarding claims to shaped parts (e.g. claims 33-35), it is understood by one of ordinary skill in the art that the sheets of Furukawa will be used in manufacture of automotive panels and electrical appliances (e.g. see column 1, lines 8-14). There is no particular structure associated with the generic recitation of a sink top, mixer tap or work top and therefore the product of Furukawa anticipates the claims reciting these structures.

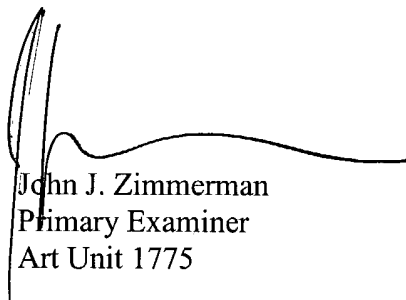
### ***Conclusion***

25. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The additionally cited references serve to further establish the level of ordinary skill in the art at the time the invention was made.

26. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John J. Zimmerman whose telephone number is (571) 272-1547. The examiner can normally be reached on 8:30am-5:00pm, M-F. Supervisor Deborah Jones can be reached on (571) 272-1535. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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27. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



John J. Zimmerman  
Primary Examiner  
Art Unit 1775

jjz  
November 4, 2004